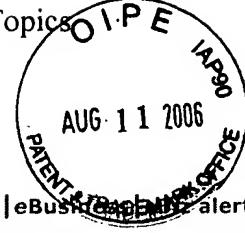


# EXHIBIT A



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This page was created 8 August 2003; updated 21 August 2003; and updated 27 January 2005 as a result of questions asked during examiner training at the USPTO; A11 was updated 9 February 2005.

**A. Amendments to Claims****B. Amendments to Specification (not including claims)****C. Amendments to Drawings****D. Non-compliant Amendments****E. After-final Amendments****F. Preliminary Amendments****G. Examiner's Amendments****H. Amendments under 37 CFR 1.312****I. Supplemental Amendments****J. Amendments file in Response to a Quayle Action****K. Markings****L. Allowance****M. Other Topics****A. Amendments to Claims****A1. What are the permissible status identifiers?**

The seven permissible status identifiers set forth in 37 CFR 1.121(c) are: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), and (Withdrawn). (Withdrawn-currently amended) is also acceptable.

**A2. If the examiner made a restriction requirement and applicant elected with traverse and filed an amendment to the claims, what status identifiers should be used for the non-elected claims that are being amended, the non-elected claims that are not amended, and new claims that are drawn to the non-elected invention?**

The non-elected claims that are amended must have the status identifier (withdrawn) or (withdrawn-currently amended). The non-elected claims that are not amended must have the status identifier (withdrawn). Any new claims that are drawn to a non-elected invention must have the status identifier (new).

**A3. When an application with several previously filed amendments and an after-final amendment that has been entered is being allowed, which set of claims would be used in printing the patent?**

The claims in the claim listing of the latest amendment (e.g., the after-final amendment) will be used in printing the patent because the claims in the claim listing of the current amendment will replace all prior claim listings and versions of claims in the application. When allowing the application, the examiner should review all of the claims being allowed, including the claims that are not currently amended, to make sure that they comply with all Office requirements and will not produce quality issues or printer queries.

**A4. Can the status identifier be presented before the claim number?**

No, the status identifier must be presented after the claim number. See 37 CFR 1.121(c).

**A5. When is a claim listing required?**

Any amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented.

**A6. Can applicant use "allowed" as the status identifier for claims that are previously indicated allowable by the examiner?**

No, applicant must use one of the permissible status identifiers. See question A1. If the claims that are indicated as allowable are not being amended in the current amendment, applicant may use either (original) or (previously presented), whichever is appropriate.

**A7. If the amendment would be compliant other than one incorrect status identifier and the examiner clearly knows the status of the claim, should the amendment be treated as a non-compliant amendment?**

Yes, a notice of noncompliant amendment (37 CFR 1.121) should be mailed to applicant to require correction. If the amendment otherwise places the application in condition for allowance, however, the examiner should correct the status identifier using an examiner's amendment.

**A8. How can an applicant reinstate a canceled claim?**

Applicant can reinstate a canceled claim by presenting the text of the canceled claim with any desired changes in a new claim with a new claim number and use the status identifier, (new).

**A9. When would applicant use the status identifier, (not entered)?**

When applicant submitted a new claim (e.g., Claim 10 (new)) in an after-final amendment that was denied entry, applicant should use the status identifier (not entered) for the new claim (e.g., Claim 10 (not-entered)) in any subsequent amendment.

**A10. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection?(posted August 14, 2003, old B1)**

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing in this situation would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

**A11. How should I amend a formula in a claim? (updated February 9, 2005; posted August 21, 2003, old B2)**

Applicants may use one of the following methods, for example, change "H4" to "H2" in a chemical formula:

(1) Strikethrough and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, C<sub>6</sub>H<sub>4</sub>(C<sub>2</sub>O<sub>3</sub>)<sub>2</sub> C<sub>6</sub>H<sub>2</sub> (C<sub>2</sub>O<sub>3</sub>)<sub>2</sub>.

(2) Doublebrackets and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, [[C<sub>6</sub>H<sub>4</sub>(C<sub>2</sub>O<sub>3</sub>)<sub>2</sub>]] C<sub>6</sub>H<sub>2</sub> (C<sub>2</sub>O<sub>3</sub>)<sub>2</sub>.

(3) Delete the claim and replace it with a new claim.

Claim 1 (canceled).

Claim 2 (new) A curing agent for epoxy resins comprising pyromellitic dianhydride, C<sub>6</sub>H<sub>2</sub> (C<sub>2</sub>O<sub>3</sub>)<sub>2</sub>.

Do not use strikethrough or doublebrackets to delete only subscript "4" and use underlining to add only subscript "2" in the formula.

**A12. In the past, I have included claim status that indicates how many times a claim has been amended, i.e., "Claim 1 (Twice Amended)." Is it proper to indicate that a claim has been "previously amended twice" or "currently amended for the third time?" (posted August 21, 2003, old B3)**

No, under the revised amendment practice, it would NOT be appropriate to indicate how many times a claim has been amended. Only the following seven status identifiers are permitted: "original", "currently amended", "canceled", "new", "withdrawn", "previously presented", and "not entered".

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## **B. Amendments to Specification (not including claims)**

### **B1. What are the requirements for filing a substitute specification?**

When applicants file a substitute specification, the following are required under 37 CFR 1.125: (1) a statement that the substitute specification includes no new matter; (2) a marked-up version of the specification with markings to show all the changes relative to the immediate prior version; and (3) a clean version of the substitute specification.

### **B2. Does the Office scan both the clean version of the substitute specification and the marked-up version into the image file wrapper (IFW)?**

Yes, both versions should be scanned into IFW.

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## **C. Amendments to Drawings**

### **C1. Is a letter to the Official Draftsman required when amendments to drawings are being submitted?**

No, a letter to the Official Draftsman is not required. Instead, drawing amendments should be treated in the same paper as amendments to the specification, claims or abstract. See 37 CFR 1.121(d). If the drawing amendments are treated in a separate paper, no objection will be made merely because a separate paper has been used so long as the requirements of 37 CFR 1.121(d) are met.

**C2. [deleted 20Jan2005, See C4]****C3. What are the requirements for submitting replacement or new drawings?**

Applicant must submit any amendments to drawings as replacement or new drawings accompanied by explanations of the changes in either the drawing amendment section or remarks section of the amendment paper. Any replacement sheets of drawings must be labeled as "Replacement Sheet" and any new sheets of drawings must be labeled as "New Sheet" in the header. The brief and detailed description of drawings should also be amended to be consistent with the changes to the drawings.

**C4. Can applicant submit proposed drawing corrections?**

The proposed drawing correction practice has been eliminated. Manual of Patent Examining Procedure (MPEP), Sections 608.02(v) and 608.02(w) previously addressed proposed drawing correction practice, and were revised in revision 2 of the Eighth Edition to reflect the annotated marked up sheet practice. See also *Changes To Implement Electronic Maintenance of Official Patent Application Records*, 1272 OG 197 (July 29, 2003), 68 Fed. Reg. 38611 (June 30, 2003). (The background for this change was discussed in the Notice of Proposed Rulemaking: "For amending drawing figures (1.121(d)), applicants would be required to submit a replacement figure with the changes made. No pre-approval of proposed changes in red ink will be required. In each situation, an explanation of the changes must be supplied." *Changes To Implement Electronic Maintenance of Official Patent Application Records*; Notice of proposed rule making 1269 OG 166 (April 22, 2003), 68 Fed. Reg. 14365 (March 25, 2003).)

If applicant wishes to make any changes to the drawings, the applicant must submit the replacement drawings that include the desired changes. In addition, applicant may submit, or may be required by the examiner to submit, a marked-up copy of any amended drawing figure, including annotations indicating the changes made.

**C5. If applicant submits proposed drawing corrections, how should the Office treat such submission?**

If applicant clearly submitted proposed drawing corrections instead of replacement drawings, a notice of non-compliant amendment should be mailed to the applicant notifying the applicant that the label "Replacement Sheet" or "New Sheet" is missing, the practice of submitting proposed drawing corrections has been eliminated, and replacement or new drawing sheets that include the amended or new figures are required. If a replacement sheet of drawings was submitted, the proposed drawing corrections should have been labeled "Annotated Marked-up Drawings" and the notice of non-compliant amendment should require this label.

**C6. Can applicant submit drawings that include only formal changes (e.g., better quality drawings) and do not include any substantive changes to the drawings?**

Yes, applicant may submit better quality drawings as replacement drawings so long as the requirements of 37 CFR 1.121(d) are met. Examiners should enter the replacement drawings even if submitted after allowance or after final because they do not include any substantive changes.

**C7. If applicant files replacement drawings without any other amendments after a non-final Office action and the replacement drawings are not filed in response to the non-final Office action, how should the Office treat such drawing submission?**

The drawing submission should be entered, but the time period for applicant to file a reply to the non-final Office action continues to run. If the drawings are in compliance with § 1.121(d), acknowledgement of the drawing submission should be indicated in the examiner's next Office action.

When the applicant subsequently files a reply, the technical support staff (TSS) will review both the drawing submission and the reply to determine whether they are in compliance with 37 CFR 1.121. If the drawing submission or the reply is non-compliant, the TSS will mail a notice of non-compliant amendment notifying applicant of the non-compliance.

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**D. Non-Compliant Amendments****D1. If an amendment that is not an after-final amendment is non-compliant, how should the Office treat the amendment?**

If a preliminary amendment, supplemental amendment filed a suspension period, or non-final amendment is non-compliant, the technical support staff should review the amendment in its entirety and point out all of the reasons for noncompliance in the Notice of Non-Compliant Amendment to notify the applicant of: (1) which section of the amendment paper is not in compliance with 37 CFR 1.121 (e.g., the amendments to the claims); (2) items that are required for compliance (e.g., a claim listing in compliance with 37 CFR 1.121(c)); and (3) the reasons why the section of the amendment fails to comply with 37 CFR 1.121 (e.g., the status identifiers are missing).

**D2. What time period for reply is set forth in the Notice of Non-Compliant Amendment if the non-compliant amendment is a reply to a non-final Office action?**

For a non-compliant amendment that is a reply to a non-final Office action, the Notice provides a time period of one month or thirty days, whichever is longer, for reply and this time period is extendable under 37 CFR 1.136(a) (e.g., up to five months after the one-month or thirty day time period). If applicant fails to file a reply to the Notice within the time period, the application will be abandoned.

**D3. What time period for reply is set forth in the Notice of Non-Compliant Amendment if the non-compliant amendment is a preliminary amendment?**

If the amendment is a preliminary amendment, the time period is 1 month or thirty days whichever is longer, and this time period is not extendable. If applicant fails to take corrective action, the examiner will examine the application without considering the changes in the non-compliant preliminary amendment.

**D4. If the reply to a non-final Office action is a non-compliant amendment, can the examiner consider the amendment and treat it on the merits?**

The examiner should not treat a non-compliant amendment on the merits unless the amendment would otherwise place the application in condition for allowance and the non-compliance is minor. For such situation, the examiner may correct the non-compliance using an examiner's amendment, and allow the application. If the amendment does not place the application in condition for allowance, the examiner should ask the technical support staff to send a Notice of Non-Compliant Amendment to the applicant to require a compliant amendment.

**D5. If the Office sent out a Notice of Non-Compliant Amendment and the reply to the Notice is still a non-compliant amendment, how should the Office treat the second non-compliant amendment?**

If the second non-compliant amendment again fails to comply with 37 CFR 1.121 for the same reason as cited in the Notice of Non-Compliant Amendment mailed by the Office, the technical support staff (TSS) should call the applicant to provide additional assistance and mail applicant a newly created form, "Failure to Acceptably Respond to Notice of Non-Compliant Amendment (37 CFR 1.121) No New Time Period for Reply is Provided."

If the second non-compliant amendment fails to comply with 37 CFR 1.121 for a different reason, the TSS should mail another "Notice of Non-Compliant Amendment (37 CFR 1.121)" identifying the new problem.

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**E. After-final Amendments****E1. If an after-final amendment is non-compliant, how should the Office treat the amendment?**

If the after-final amendment does not place the application in condition for allowance, the examiner should provide reasons for non-entry (e.g., the proposed amendment raises new issues that would require further consideration and/or search) in an advisory action. Furthermore, the examiner should also indicate in the advisory action the sections of the amendment that are non-compliant and the reasons why the amendment fails to comply with 37 CFR 1.121. The examiner may attach a Notice of Non-Compliant Amendment to the advisory action.

The time period continues to run from the mailing of the final Office action. No new time period is provided to correct the non-compliance. If time remains in the time period for reply set forth in the final Office action, applicants may resubmit the entire corrected after-final amendment within the time period set forth in the final Office action accompanied by the appropriate extension of time fee, if required.

**E2. If an after-final amendment that is a non-compliant amendment would otherwise place the application in condition for allowance, can the examiner enter the amendment, correct the non-compliance and allow the application?**

Yes, the examiner may enter the after-final amendment and provide an examiner's amendment to correct the non-compliance.

**E3. If the examiner wants to correct the non-compliance in an after-final amendment and allow the application within the six-month statutory period, can the examiner provide substantive changes in the examiner's amendment?**

Yes, when the after-final amendment substantially places the application in condition for allowance, the examiner may request that the applicant authorize an examiner's amendment to correct the non-compliance along with any other substantive omissions/changes to place the application in condition for allowance if such authorization is provided within the six-month statutory period set forth in the final Office action, and any required extensions of time are authorized.

**E4. If the applicant filed an after-final amendment that is non-compliant within the statutory time period with the appropriate extension of time fee, can the examiner allow the application after the six-month statutory period by correcting the non-compliance in an after-final amendment?**

Only when the non-compliance is minor in the after-final amendment that would otherwise place the application in condition for allowance, the examiner may provide an examiner's amendment without an authorization from the applicant to correct the non-compliance if such examiner's amendment is limited to correcting the format errors or any typographical errors and does not make any substantive changes to the claims and/or specification. For example, if some of the status identifiers are improper or missing, the examiner may provide in the examiner's amendment a complete claim listing with the proper status identifiers or instructions to correct (e.g., for claim 2, change the status identifier "twice amended" to "previously presented").

**See Section G for more questions regarding examiner's amendments.**

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**F. Preliminary Amendments**

**F1. Is a claim listing required for preliminary amendments present on the filing date of the application?**

Yes, a claim listing of every claim ever presented in the application is required, even for preliminary amendments present on the filing date of the application. The status identifier, (new), instead of (original), should be used for claims added by a preliminary amendment, even when the preliminary amendment is present on the filing date of the application and the first executed oath or declaration refers to the preliminary amendment. Only the claims presented in the original specification should be identified using the status identifier, (original). Claims that are canceled by a preliminary amendment present on the filing date of the application are required to be listed and identified using the status identifier, (canceled), in the preliminary amendment and any subsequent amendments.

**F2. If applicant files: (1) a continuation application including the set of claims of the parent application, and (2) an accompanying preliminary amendment that cancels all of the claims and presents a new set of claims, should the applicant use the status identifier, (original), for the claims added by the preliminary amendment?**

No, applicant must not use the status identifier, (original), for claims added by a preliminary amendment, even if the preliminary amendment is present on the filing date of the application and it is filed on or after October 21, 2004, the effective date of the changes to 37 CFR 1.115. Any new claims added by an amendment, including a preliminary amendment, must have the status identifier, (new). If applicant files a subsequent amendment, applicant must use the status identifier "previously presented" if the claims added in the preliminary amendment are not being amended, or "currently amended" if the claims added in the preliminary amendment are being amended.

**F3. If applicant wants to file an application with a preliminary amendment that will cancel all of the claims in the original specification and add a new set of claims, can the claim numbers of the claims in the original specification be reused for the claims added by the preliminary amendment?**

No, the original numbering of the claims must be preserved throughout the prosecution in compliance with 37 CFR 1.126. Therefore, the claim listings presented in the preliminary amendment and any subsequent amendment must include the claims in the original specification with the status identifier (canceled), and the new set of (added) claims should start with the next higher claim number.

**F4. If the transmittal letter of the application includes an amendment to the first sentence of the specification to add a benefit claim, how should such amendment be treated?**

The Office will treat such amendment as a non-compliant amendment by sending applicant a notice of non-compliant amendment. Any preliminary amendment to the specification must be present on a separate sheet. See 37 CFR 1.121(h).

**F5. If an application is filed with a preliminary amendment to add several new claims, does the preliminary amendment have to include a complete listing of all claims in compliance with revised 37 CFR 1.121? (posted August 14, 2003, old A1)**

Yes, the preliminary amendment must be filed in compliance with revised 37 CFR 1.121 with a complete listing of the claims. The new claims should have the status identifier, "new".

Applicant should not use the status identifier, "original" for the claims added in the preliminary amendment, even if the application was filed with an oath or declaration that has a statement referring to the preliminary amendment.

If applicant files a subsequent amendment that includes a complete listing of the claims, applicant should use the status identifier, "previously presented" (if the claims added in the preliminary amendment are not being amended), or "currently amended" (if the claims added in the preliminary amendment are being amended).

Filing an application with a preliminary amendment is not recommended. Applicants are encouraged to file the application with a specification that includes the desired set of claims. See File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office 54 (October 9, 2001).

**F6. Can applicant use the transmittal letter of a continuation or divisional application to amend the first sentence of the specification to add the benefit claim to the parent application? (posted August 14, 2003, old A2)**

No, a preliminary amendment cannot be made in a transmittal letter or form for the filing of an application. The amendment to the specification that adds the specific reference to the parent application in the first sentence of the specification following the title must be provided on a separate sheet of paper in compliance with revised 37 CFR 1.121.

Applicant may wish to provide the specific reference in an application data sheet (ADS) under 37 CFR 1.76 or in a

new specification instead of filing a copy of the specification of the parent application with a preliminary amendment.

The Office transmittal forms will no longer permit any preliminary amendment to be made in the transmittal form. If applicants are using a transmittal form that provides a box for a preliminary amendment, applicants are advised not to use such box, but to provide the preliminary amendment on a separate sheet of paper in compliance with revised 37 CFR 1.121.

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#### **G. Examiner's Amendments**

**G1. If the amendment that would otherwise place the application in condition for allowance (e.g., a reply to a non-final Office action or an after-final amendment) includes minor non-compliance such as an incorrect status identifier, can the examiner correct the non-compliance and allow the application?**

Yes, the examiner may enter the non-compliant amendment and correct the non-compliance in an examiner's amendment. Since the correction is not substantive, the examiner may make the correction in an examiner's amendment without the applicant's authorization and/or after the statutory period for reply set forth in the last Office action.

Note: Examiner's amendments are at the discretion of the examiner and applicants should not expect examiner's to take corrective action if an amendment fails to comply with 37 CFR.

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#### **H. Amendments under 37 CFR 1.312**

**H1. Can the examiner enter an amendment under 37 CFR 1.312 in part, e.g., not enter one of the amended claims?**

No, in IFW, the entire amendment to the claims must be entered as a whole or denied entry.

**H2. How should amendments to drawings filed after allowance be treated?**

Amendments to drawings filed after allowance are entered by the Office of Publications. If such amendment is forwarded to the examiner, the examiner should forward or return the application to the Office of Publications. The examiner should not deny entry of any drawing submission that includes only formal changes.

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#### **I. Supplemental Amendments**

**I1. If the supplemental amendment filed on or after October 21, 2004 during a non-suspension period is matched with the application before the examiner considers the first reply, but the supplemental amendment is non-compliant, how should the examiner treat the supplemental amendment?**

Examiner may either: (1) deny the entry of the supplemental amendment, or (2) enter the supplemental amendment and correct the non-compliance in an examiner's amendment if the supplemental amendment

otherwise places the application in condition for allowance. If the examiner denies the entry of the supplemental amendment, the examiner should indicate that the supplemental reply is not being entered in the next Office communication using form paragraph 7.147.

**12. If the supplemental reply filed in compliance with 37 CFR 1.121 is scanned into the IFW and forwarded to the examiner after the examiner starts acting on the first reply, can the examiner deny entry of the supplemental reply?**

Yes, the examiner may deny entry of the supplemental reply if the supplemental reply is filed on or after October 21, 2004, in a non-suspension period, and it not limited to one of the situations listed in 37 CFR 1.111(a)(2)(i).

**13. If the supplemental reply is not limited to one of the situations listed in 37 CFR 1.111(a)(2)(i), can the examiner enter the supplemental reply?**

Yes, the examiner has the discretion to enter any supplemental reply that is in compliance with 37 CFR 1.121, even if the reply adds more claims or includes an affidavit. For example, if the first reply includes an unsigned declaration and applicant subsequently files a signed declaration in a supplemental reply, the examiner should enter such supplemental reply if it is matched with the application before the examiner finishes the next action.

**14. If the first reply is a non-compliant amendment, can the applicant file an amendment that includes additional changes to the specification, including claims, in response to a notice of non-compliant amendment?**

Yes, the corrected amendment filed in response to a notice of non-compliant amendment can include additional changes and it would not be considered as a supplemental reply.

**15. If a supplemental reply is filed within the period during which action by the Office is suspended and it is a non-compliant amendment, how would such amendment be treated?**

A technical support staff person reviews supplemental amendments filed during a suspension period to determine whether the amendments are in compliance with 37 CFR 1.121. If such a supplemental reply is non-compliant, a notice of non-compliant amendment should be mailed to the applicant. It will provide applicant one-month or 30 days, whichever is longer, to file a corrected amendment. If applicant fails to file a timely corrected amendment in response to the notice, the application will be examined (after the period of suspension) without consideration of the supplemental reply.

**16. Applicant filed an after-final amendment and then subsequently filed an amendment with a request for continued examination (RCE) under 37 CFR 1.114. Would the amendment filed with the RCE be considered a supplemental amendment and, thus, not be entered as a matter of right?**

No, such an amendment is not a supplemental amendment. Any amendment filed with an RCE under 37 CFR 1.114 will be entered because it is a submission under 37 CFR 1.114(c) to the RCE. The Office will enter any previously filed unentered after-final amendment and the amendment filed with the RCE in the order in which they were filed, unless the applicant provides instructions not to enter the after-final amendment. To avoid non-compliance under 37 CFR 1.121 and simplify the entry of the amendments, applicant may file an amendment that includes any desired changes in the unentered after final amendment, and instructions not to enter the after-final amendment, when filing the RCE.

**17. Applicant files a request for continued examination (RCE) under 37 CFR 1.114 after receiving an advisory action that notifies the applicant that an after-final amendment will not be entered. The Office entered the RCE and the after-final amendment as the submission to the RCE. Would an amendment or affidavit filed shortly after the filing of the RCE be considered a supplemental reply and, thus, not be entered as a matter of right?**

Yes, such an amendment or affidavit filed after the filing of an RCE under 37 CFR 1.114 will not be entered as a matter of right unless a request for suspension of action under 37 CFR 1.103(c) and the required fee are filed with the RCE.

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#### **J. Amendments file in Response to a Quayle Action**

##### **J1. How would the Office treat non-compliant amendments filed in response to an Ex Parte Quayle action?**

Amendments filed in response to a Quayle action are reviewed by technical support staff (TSS). If a reply to a Quayle action is a non-compliant amendment, a notice of non-compliant amendment should be mailed by TSS to the applicant notifying the applicant of the non-compliance. To avoid abandonment of the application, applicant must file an amendment in compliance with 37 CFR 1.121 within one-month or 30 days, whichever is longer, from the mailing of the notice. The time period is extendable under 37 CFR 1.136(a).

When a corrected amendment is filed in response to the notice, the corrected amendment is forwarded to the examiner to consider the amendment on the merits. The examiner may deny entry of the amendment if the amendment touches the merits of the application (e.g., adding more claims) since the prosecution is closed.

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#### **K. Markings**

##### **K1. How should applicant indicate added text when the character to be added is the greater than (>) or less than (<) symbol in a formula to avoid confusion with the greater than and equal to symbol (>) or the less than and equal to symbol (<)?**

Applicant should delete the whole formula and add the new formula with the desired changes by using double brackets to delete the formula and underlining to add the new formula. For example: [[A + B = C]] A + B > C.

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#### **L. Allowance**

##### **L1. How should the examiner indicate that the claims that have the status identifiers "withdrawn" are rejoined and allowed?**

At the time of allowance, the examiner must indicate that the claims are being allowed in the index of claims and on the Notice of Allowability to avoid a printer query. In addition, examiners are encouraged to provide an explanation on the record either on the Notice of Allowability (e.g., under the section, "Other") or in the reasons for allowance to notify the applicant that the non-elected claims are rejoined and allowed.

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#### **M. Other Topics**

##### **M1. Applicant canceled a claim and renumbered the other claims during the international stage of an international application that has subsequently entered the national stage. Applicant would like to file a preliminary amendment to the claims in the national stage of the international application, what status identifier(s) should he/she use for the renumbered claims? (posted August 14, 2003; revised August 21, 2003, old E1)**

Assuming that the amendment under Article 19 or 34 made during the international phase is entered in the U.S. national stage application (this will not be the case where, for example, a required English translation of the amendment is not timely furnished), the status identifier, "previously presented", should be used for renumbered claims that are not being amended in the preliminary amendment. The status identifier, "currently amended", should be used for renumbered claims that are being amended in the preliminary amendment.

For example, an applicant filed an international application that originally included independent claim 1, and

dependent claims 2, 3 and 4. During the international stage, Claim 1 was amended, claim 3 was canceled, and claim 4 was renumbered as claim 3. If the amendment made during the international phase is entered in the U.S. national stage application, then a preliminary amendment adding two new claims would include a claim listing as follows:

Claim 1 (previously presented)

Claim 2 (original)

Claim 3 (previously presented)

Claim 4 (new)

Claim 5 (new)

**M2. How can an applicant obtain copies of cited U.S. patent references if they do not have access to the Internet?**

If an applicant or a practitioner chooses not to print copies of U.S. patents and patent applications publications through the USPTO Patents on the Web system or through the E-Patent Reference system, commercial sources that provide patents very quickly and inexpensively are available, and copies of U.S. patents and patent application publications are also available at the Patent and Trademark Depository Libraries (PTDLs). A listing of PTDLs is located on the USPTO web site at [http://www.uspto.gov/web/offices/ac/ido/ptdl/ptdl\\_1.html](http://www.uspto.gov/web/offices/ac/ido/ptdl/ptdl_1.html). Additionally, the cost of patents if ordered from the USPTO Office of Public Records is very reasonable (\$3). For more information, see "USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies," 1282 OG 109 (May 18, 2004).

<http://www.uspto.gov/web/offices/com/sol/og/2004/week20/pataces.htm>.

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